

In re

and Trademarks of the Director's decision denying credit for petitioner's answers to questions 20, 33, 38, 41 and 47. Petitioner urges that two points be added to her score for each of these questions, and that she thereby be awarded a passing grade for the morning section of the examination held on August 28, 1996.

Opinion

Petitioner bears the burden of establishing error in the grading of her answers to examination questions 20, 33, 38, 41 and 47. 37 C.F.R. § 10.7(c). All of petitioner's arguments have been considered and, for the following reasons, no points will be added to her morning section score for the examination held on August 28, 1996.

Question 20

Question 20 reads as follows:

20. In July 1996, a recently registered patent agent, who is not a lawyer, asked a registered patent attorney to help the agent establish a practice. Which one of the following choices best comports with the professional responsibilities of both the agent and the attorney?
- (A) The agent advertises as a registered practitioner authorized to practice before the Office in patent and trademark cases, and the attorney supervises all the trademark work done by the agent.
 - (B) The agent advertises on television and radio as a registered patent agent and accepts patent cases on a contingent fee basis.
 - (C) The attorney has the agent prosecute trademark applications before the Office and the attorney signs all the papers submitted to the Office without reading the papers.
 - (D) The attorney and agent enter a partnership agreement that has no health or retirement benefits and that specifies that after termination of the partnership, the agent and the attorney will not practice in each other's neighborhoods or accept each other's established clients.
 - (E) Without receiving anything of value from the agent, the attorney refers patent application clients to the agent, the agent informs the clients that the agent is a registered patent attorney, and the agent competently represents clients in patent cases.

The correct answer is (B). More specifically, the question is directed to proper conduct by patent attorneys and agents. It is clear that practitioners, which include registered patent agents (37 C.F.R. § 10.1(r)(1)), may advertise on television and radio. 37 C.F.R. § 10.32(a). Additionally, a registered patent agent may accept cases on a contingent fee basis. See 37 C.F.R. § 10.36(b)(8) (permits contingent and fixed fees that are not clearly excessive or illegal). On its face, answer (B) does not include any fact that is contrary to the Patent Practitioner Rules of Conduct found in 37 C.F.R., Part 10.

Petitioner argues that answer (B) contains information other than what is recited in the answer choice. See Petition at 3-8 (arguing that an unreasonable fee arrangement or improper types of advertising are not necessarily ruled out by the answer choice). However, these possibilities are simply not part of that answer choice. The answer choice is clear on its face and does not run afoul with the rules of conduct.

Petitioner argues that answer (D) is the correct answer to question 20. However, practitioners shall not enter into partnership agreements that restrict their right to practice before the PTO. 37 C.F.R. § 10.38(a). Since this answer includes a partnership agreement stating "after termination of the partnership, the agent and the attorney will not practice in each other's neighborhoods or accept each other's established clients," answer (D) is contrary to § 10.38(a) and is therefore not the correct answer to question 20. Petitioner makes rather convoluted arguments about how this answer could be the correct one. Petition at 6-8 (e.g., retirement benefits could be a condition on the restriction to practice, "[t]he practice could be a dental practice and the established clients could be dental patients"). However, such arguments do not negate the fact that answer (D) includes, on its face, an element that is contrary to 37 C.F.R.

§ 10.38(a) and is therefore an improper answer.

In view of the above, the Director did not err in denying petitioner credit for her answer to question 20.

Question 33

Question 33 reads as follows:

33. You have filed an appeal brief for your appeal to the Board of Patent Appeals and Interferences. The primary examiner has furnished you with her examiner's answer dated August 1, 1996, which does not contain new points of argument or a new ground of rejection. On August 15, 1996, the U.S. Court of Appeals for the Federal Circuit entered a decision that directly affects the merits of your appeal at the Board. You are aware of this decision today. Which of the following answer choices sets forth the appropriate way or ways to make the Board aware of this decision?
- I. By filing a supplemental appellant's brief with the Board.
 - II. By making a timely request for an oral hearing and presenting the decision at the hearing.
 - III. By addressing it in a reply brief.
- (A) I and III.
 - (B) II.
 - (C) III.
 - (D) II and III.
 - (E) I and II.

The correct answer is (E). When new controlling authority issues, the applicant may file a supplemental brief with the Board of Patent Appeals and Interferences. 37 C.F.R. § 1.192(a); Manual of Patent Examining Procedure (hereafter "MPEP") § 1206 ("37 CFR 1.192(a) is not intended to preclude the filing of a supplemental paper if a new argument or authority should become available or relevant after the brief was filed"). Accordingly, option I is an appropriate way to make the Board aware of the decision. Additionally, new arguments can be presented at oral argument when good cause, such as the issuance of new controlling authority, is shown. See

37 C.F.R. § 1.192(a); MPEP § 1206. Thus, option II is another appropriate way to make the Board aware of the new decision.

Option III involves filing a reply brief to present the new authority. A reply brief may only be directed to new points of argument made in the examiner's answer or new grounds of rejection set forth in the answer. 37 C.F.R. § 1.193(b). The question specifically states, however, that the earlier-filed examiner's answer "does not contain new points of argument or a new ground of rejection." Therefore, option III is not an appropriate way to make the Board aware of the new decision. 37 C.F.R. § 1.193(b). Accordingly, answer (E) is the correct choice because it includes options I and II, but not option III.

Petitioner argues that option I is not an appropriate way to make the Board aware of the new decision because the choice does not specifically state that the decision will be referenced or presented in the supplemental brief. Petition at 10-13. However, this option states that a supplemental brief will be filed and all of this is set forth in the context that the new authority is to be presented to the Board. Reading the option as not including reference to the new supplemental authority, but including reference to something else, is not a rational construction of the option, given the context of the choice within the question. Petitioner's argument on this matter has been considered but has been determined to be without merit.

In view of the above, the Director did not err in denying petitioner credit for her answer to question 33.

Question 38

Question 38 reads as follows:

38. Joe filed a patent application on June 1, 1996. The only description in the application of the best mode is made by way of a reference to a Japanese

patent. Joe should:

- (A) Do nothing because it is acceptable to disclose the best mode by an incorporation by reference.
- (B) File an amendment which amends the specification to include the material incorporated by reference and file a petition [sic, to] the Commissioner stating that the incorporation by reference was inadvertent and requesting that the application be accorded the original filing date.
- (C) File an information disclosure statement that discloses the Japanese patent and is accompanied by a copy of the Japanese patent.
- (D) File an amendment which amends the specification to include the material incorporated by reference along with an affidavit stating that the included material is the same as the material incorporated from the Japanese patent.
- (E) Abandon the application and refile a new application that includes a description of the best mode in the specification without incorporating by reference.

The correct answer is (D). MPEP § 608.01(p) directly addresses how to cure the incorporation of essential material by reference to a foreign patent. When such a situation occurs, "the applicant will be required to amend the specification to include the material incorporated by reference . . . [t]he amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application." MPEP § 608.01(p). This is precisely the procedure set forth in answer (D).

Petitioner argues that the question is ambiguous on the ground that it does not positively state that the Japanese patent "actually disclosed" the best mode. Petition at 15-19. This argument is without merit. The question reads in pertinent part "[t]he only description in the application of the best mode is made by way of a reference to a Japanese patent." Reference to the Japanese patent for the best mode means just that, *i.e.*, it had the best mode and was incorporated by reference into the patent application.

In view of the above, the Director did not err in denying petitioner credit for her answer to question 38.

Question 41

Question 41 reads as follows:

41. Inventor has been prosecuting his own patent application. He has just received a final rejection from the examiner under 35 U.S.C. § 103. In the spirit of "never say die," Inventor has hired Attorney to handle an appeal. Attorney, sole practitioner in his office, files the appellant's brief. Attorney does an excellent job of explaining how the specific limitations in the rejected claims are not described in the prior art. Upon reading this brief, the examiner maintains the 35 U.S.C. § 103 rejection and enters a new ground of rejection under 35 U.S.C. § 112. Attorney is presently tied up in an out-of-state trial which promises to last for two months. What should Attorney do with regard to the Examiner's Answer?
- (A) File a reply brief which addresses all the arguments she had previously made as well as additional arguments directed to the 112 rejection.
 - (B) Not file a reply brief at all and let the Board decide based on the main briefs and the record.
 - (C) Authorize Attorney's law clerk to prepare and file a reply brief addressing only the new rejection raised by the examiner.
 - (D) File a petition with reasons for an extension of time to file a reply brief four months from the date of the Examiner's Answer.
 - (E) File a reply brief accompanied by an amendment appropriate to the 35 U.S.C. § 103 rejection.

The correct answer is (D). More time will be needed after the two month deadline, imposed by 37 C.F.R. § 1.193(b), to respond to the new ground of rejection, due to the other pressing work of a two month trial imposed by a court. Accordingly, the attorney has "sufficient cause" under 37 C.F.R. § 1.136(b) to get a "reasonable" extension of time of two months.

Petitioner argues that answer (D) does not state that the intervening trial establishes sufficient cause and that the two month request for an extension is a reasonable amount of time. Petition at 21-22, 24. However, just like in practice, a registered practitioner would not have

those precise answers before filing the request for an extension of time. What the practitioner does have, though, is a solid argument that, given the circumstances, he or she had sufficient cause for an extension of time that reasonably corresponded to the period of time of the other matter causing the delay. Petitioner simply expects too much information to be in this answer.

Petitioner also argues that answer (A) is more correct than answer (D), but fails to overcome the problem that answer (A) violates 37 C.F.R. § 1.193(b), which limits a reply brief to addressing only a new ground of rejection or a new point of argument raised in an examiner's answer. Answer (A) is not correct, given what it recites and the limitations imposed by 37 C.F.R. § 1.193(b). Petitioner's arguments to the contrary are not persuasive.

In view of the above, the Director did not err in denying petitioner credit for her answer to question 41.

Question 47

Question 47 reads as follows:

47. On July 10, 1995, your client published an article containing a complete and enabling disclosure of a new pharmaceutical compound he developed. On August 10, 1995, you prepared and filed a provisional application for the client containing an enabling disclosure of the pharmaceutical compound disclosed on the publication. The provisional patent application was filed using the Express Mail Service of the U.S. Postal Service and included a proper certificate of express mailing. On Saturday, August 10, 1996, you deposit a complete (non-provisional) U.S. patent application that claims the new pharmaceutical compound and which claims priority to the filing date of the provisional application under 35 U.S.C. § 119(e) with the U.S. Postal Service using the Express Mail Service and include a proper certificate of express mailing. The application is received in the PTO mail room on August 13, 1996. The claims to the pharmaceutical compound are:

(A) Patentable over your client's article. The effective filing date of the complete application is August 10, 1995. Because the article was written by the inventor and was published less than one year before

- the effective filing date of the complete application, the inventor can swear behind the article's publication date.
- (B) Unpatentable. The effective filing date of the complete application is August 12, 1996, and thus the claims to the compound are barred by the publication of your client's article more than one year before the complete application's effective filing date.
 - (C) Patentable over your client's article. The effective filing date of the complete application is August 10, 1996. However, because the article was written by the inventor, the inventor can swear behind the article's publication date.
 - (D) Patentable over your client's article because the article is not prior art.
 - (E) Unpatentable. The effective filing date of the complete application is August 13, 1996, and thus the claims to the compound are barred by the publication of your client's article more than one year before the complete application's effective filing date.

The correct answer is (B). More specifically, since the above-identified express mailing was done on a Saturday, the filing date afforded by the PTO under the then current rules was the next business day, August 12, 1996. 37 C.F.R. § 1.6(a)(2)(1996) (amendment to afford filing date as express mail date regardless of whether mail date was Saturday, Sunday or Federal holiday within the District of Columbia became effective on December 2, 1996). However, the provisional application expired on August 10, 1996, one year after its filing date, without the possibility of revival. 35 U.S.C. § 111(b)(5). Thus, co-pendency does not exist between the two applications and the later-filed non-provisional application is therefore left with a filing date of August 12, 1996. 35 U.S.C. § 119(e)(1) (requires co-pendency between the provisional and non-provisional applications in order to receive the benefit of the earlier filing date). Accordingly, since the invention was described in a printed publication on July 10, 1995, more than one year before the filing date, the application is now barred. 35 U.S.C. § 102(b).

Petitioner argues that the fact pattern in this question did not make it clear that proper Express Mailing procedure was used and therefore answer (E), which has the actual receipt date as the filing date, is the correct answer to this question. Petition at 27-31. This argument is also

without merit. The question states that the non-provisional application was deposited "with the U.S. Postal Service using the Express Mail Service and include[d] a proper certificate of express mailing." A "proper" certificate of express mailing means that the procedure was properly used to get the benefit of August 12, 1996, pursuant to 37 C.F.R. § 1.6(a)(2) (1996). Contrary to petitioner's argument, nothing needs to be read into the question.

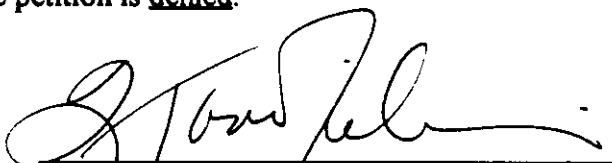
In view of the above, the Director did not err in denying petitioner credit for her answer to question 47.

ORDER

Upon consideration of the petition to the Commissioner for a higher score on the morning section of the examination held on August 28, 1996, it is

ORDERED that the petition is denied.

7/9/98
Date



Q. TODD DICKINSON
Deputy Assistant Secretary of Commerce and
Deputy Commissioner of Patents and Trademarks